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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,556	06/13/2001	Harold Brodie	S1011	9517

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/11/2001

5

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-15

<b>Office Action Summary</b>	<b>Application No.</b> 09/880,556	<b>Applicant(s)</b> BRODIE ET AL.	
	<b>Examiner</b> Anthony J. Green	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
    If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
    a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Reissue Applications***

#### ***Response to Preliminary Amendment***

1. Applicants preliminary amendment submitted on 13 JUNE 2001 is improper as the amendment is not in accordance with 37 CFR §1.173(b)(2), (c), (d)(1)(2), and (e) as applicants (1) have not provided the status of the claims (i.e. amended etc.), (2) have not shown the support for all claims that were added, (3) have not shown the changes made to the claims using brackets and underlining, and (4) have not preserved the numbering of the patent claims.

#### ***Oath/Declaration***

2. The reissue oath/declaration filed with this application is defective because

- (a) it fails to properly identify the specification to which it is directed.
- (b) it fails to identify each inventor's post office address.
- (c) it fails to properly identify at least one error which is relied upon to support the reissue application. Applicant statement of "I verily believe....by failing to include claims of the scope of those included in the accompanying Preliminary Amendment Presenting new claims" is not an acceptable statement of an error. Applicant must identify specific changes or amendments to the

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claims. If new claims are presented their differences from the original claims must be pointed out.

See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. (d) it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

4. Claims 1-32 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-12, 15-16, 19-27, and 29-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

No literal support can be found in the specification for the claimed subject matter.

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7. Claims 10-12, 15-16, 19-27, and 29-32 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claims 10 and 15 applicant recites "resin based powder" which is broader than that of the disclosure as the disclosure requires that the powder be a polymer powder.

Claim 12 recites that the agents are in solid form whereas this feature is not clear from the specification.

In claim 16 applicant recites "a powder coating pre-mix" which is broader than that of the disclosure as the disclosure requires that the powder be a polymer powder.

In claims 19-27 and 30 applicant recites that the biocide is a liquid and recites various types however these limitations are not present in the specification.

In claim 29 applicant recites that the mixture is melted, then cooled and then processed into the powder however these limitations are not present in the specification.

In claim 32 applicant recited various process steps that are not found in the process recited in the specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-12, 15-17, 20-27 and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing as written as it is unclear as to whether the particles each comprise a thermosetting polymer powder and an organic biocide or if the composition contains both polymer powders and an organic biocide (i.e. separate from each other). Clarification is requested.

In claim 10 the phrase “the particles” lacks proper antecedent basis. It is unclear as to the types of resin based powders encompassed by the claim. It is unclear as to the amount of anti-microbial agent encompassed by the claim.

Claim 11 is confusing as it is unclear as to whether or not the “thermosetting and/or thermoplastic compositions” are used as the resin based powder or if they are in addition to the powder. The claim is inconsistent with claim 10 as claim 10 recites “an anti-microbial agent” whereas claim 11 recites “one or more anti-microbial agents”.

Claim 12 is inconsistent with claim 10 as claim 10 recites “an anti-microbial agent” whereas claim 12 recites “anti-microbial agents”.

In claim 15 it is unclear as to the types of resin based powders encompassed by the claim. It is unclear as to the amount of anti-microbial agent encompassed by the claim.

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In claim 16 it is unclear as to the types of powder coating pre-mix encompassed by the claim. It is unclear as to the amount of anti-microbial agent encompassed by the claim.

In claim 17 the phrase “ a mixing precursors” makes no sense. The phrase “the granules” lacks proper antecedent basis.

In claim 29 the phrases “the mixture” and “the solid extrudate” lack proper antecedent basis.

In claim 31 the phrase “the powder coating particles” lacks proper antecedent basis.

In claim 32 the phrases “the other components” and “the powder coating formulation” lack proper antecedent basis.

10. Claims 1-12, 15-16, 20-27 and 29-32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within

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the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the parent application applicant amended the claims to recite (1) that the polymer powder is a thermosetting polymer, (2) that the biocide is organic in nature and (3) that the composition is in the form of particulates each comprising the polymer powder containing the biocide in order to overcome the art rejections and accordingly since all these limitations are not present in independent claims 1, 10, 15 and 16 it appears that applicant is attempting to recapture subject matter surrendered in the parent application. Applicant's attention is drawn to the pages 4-5 of the response filed on 21 May 1999 in the parent application wherein applicant argues that the insertion of these limitations overcomes the art rejections.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 10, 12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cueman et al (US Patent No. 5,238,749).



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The reference teaches an antimicrobial composition comprising a thermoplastic or thermosetting powder and an antimicrobial agent (see col. 4, lines 45-55, col. 6, lines 34- 45 and col. 8, lines 1-19.

No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 10 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference.

13. Claims 10, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 06-025561.

The reference teaches, according to the abstract (WPIDS 94-072114), an antibacterial paint composition comprising a nylon powder and a powdery biocidal agent.

No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 10 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference.

14. Claims 10-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 08-060036.

The reference teaches, according to the abstract (JP408060036A), an antibacterial, antifungal polyester resin composition comprising a polyester powder and zeolite carrying an antibacterial, antifungal metal in powder form.

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No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 10 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference.

### ***Double Patenting***

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claims 14 and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11 and 13 of prior U.S. Patent No. 6,129,782. This is a double patenting rejection.

### ***Request To Provoke Interference***

17. Applicant's request to provoke an interference is acknowledged however it should be noted that no interference can be declared until there is at least one allowable claim which corresponds to a proposed count of the interference.

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***Surrender Of Original Patent***

18. Applicant is reminded that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

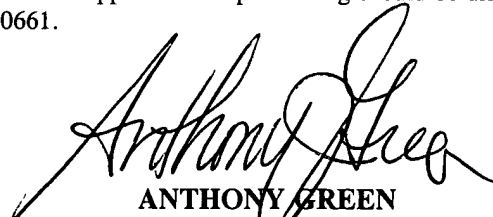
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Green whose telephone number is (703) 308-3819. The examiner can normally be reached on Monday - Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone numbers for the Group are as follows:

- (i) (703) 872-9310 for any non-final amendment or communication, and
- (ii) (703) 872-9311 for any after-final amendment or communication.

It is suggested that the examiner be notified that a fax has been sent to ensure prompt handling of the amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**ANTHONY GREEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1755**

ajg  
December 11, 2001